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| 10/801,474 | 03/12/2004. | Anthony Dennis Boulton | SWIN 2857 | 1798 |

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| EXAMINER | |
|---|---|
| LEE, BENJAMIN WILLIAM | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3709 | |

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/801,474 | BOULTON, ANTHONY DENNIS | |
| | Examiner | Art Unit | |
| | Benjamin W. Lee | 3709 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *15-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8-27-2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. The preliminary amendment filed 3-12-2004 has been entered.

### *Specification*

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because of the inclusion of legal phraseology "means" in line 3. Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities:

Page 1, line 6: "to gaming" should be changed to -- to a gaming --.

Page 1, line 15: "provided gaming" should be changed to -- provided a gaming --.

Page 3, line 19: "insert slot 24" is suggested to be changed to -- coin receiving slot 24 -- in order to be consistent with the terminology used in Page 3, line 30.

Page 3, lines 19-20: "reject slot 26" is suggested to be changed to -- coin reject slot 26 -- in order to be consistent with the terminology used in Page 4, line 3.

Page 3, line 23: "Fig. 2" should be changed to -- Fig. 3 --.

Page 4, line 28: "to" should be changed to -- of --.

Page 4, lines 28-30: It is suggested to combine the two sentences to read -- In use, when a player inserts coins of an appropriate value into the coin receiving slot 24, the processor 28 then causes the screen 14 to display representations of five cards 52A-52E, as shown in Figs. 1 and 2. --.

Appropriate correction is required.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required.

The limitations "symbol providing means for..." in claim 15, lines 1-2, "display means for..." in claim 15, lines 3-4, "symbol control means for..." in claim 15, lines 4-8, "selection means operable by the user for..." in claim 15, lines 8-9, and "win means for..." in claim 15, lines 11-13 invoke 35 U.S.C. 112, sixth paragraph. The corresponding structure for the display means is understood to be the screen 14 (see Page 3, line 10) and the corresponding structures for the selection means are understood to be the buttons 16A-16E (see Page 5, lines 15-27) or a touch sensitive screen (see Page 6, lines 5-8). However, it is unclear which structures, if any, correspond with "symbol providing means," "symbol control means," and "win means." The specification should explicitly state, with reference to the terms and phrases of the means-plus-function claim elements, what structures, materials, or acts perform the functions recited in the claim elements. No new matter should be introduced to the disclosure of the application.

### *Claim Objections*

6. Claims 15, 21 and 26-28 objected to because of the following informalities:

Claim 15, line 8: "and" should be deleted.

Claim 15, line 11: "condition." should be changed to -- condition; --.

Claim 21, line 2: "valves" should be changed to -- values --.

Claim 26, line 2: "apparatus" should be changed to -- apparatuses --.

Claim 26, line 5: "said apparatus" should be changed to -- said gaming apparatuses --.

Claim 27, line 4: "apparatus" should be changed to -- apparatuses --.

Claim 28, line 9: "and" should be deleted.

Claim 28, line 12: "condition." should be changed to -- condition; --.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 15-25 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 15: The limitations "symbol providing means for..." in lines 1-2, "display means for..." in lines 3-4, "symbol control means for..." in lines 4-8, "selection means operable by the user for..." in lines 8-9, and "win means for..." in lines 11-13 invoke 35 U.S.C. 112, sixth paragraph. The corresponding structure for the display means is understood to be the screen 14 (see Page 3, line 10) and the corresponding structures for the selection means are understood to be the buttons 16A-16E (see Page 5, lines 15-27) or a touch sensitive screen (see Page 6, lines 5-8). However, it is unclear which structures, if any, correspond with "symbol providing means," "symbol control means," and "win means." It appears the processor/processing means 28 functions as the "symbol providing means," "symbol control means," and "win means." The claim has been treated as such.

Re claims 16-25: The claims are dependent upon claim 15 and thus have the same deficiencies.

Re claim 28: The limitations "symbol providing means for..." in lines 2-3, "display means for..." in lines 4-5, "symbol control means for..." in lines 5-9, "selection means operable by the user for..." in lines 8-9, and "win means for..." in lines 12-14 invoke 35 U.S.C. 112, sixth paragraph. The corresponding structure for the display means is understood to be the screen 14 (see Page 3, line 10) and the corresponding structures for the selection means are understood to be the buttons 16A-16E (see Page 5, lines 15-27) or a touch sensitive screen (see Page 6, lines 5-8). However, it is unclear which structures, if any, correspond with "symbol providing means," "symbol control means," and "win means." It appears the processor/processing means 28

functions as the "symbol providing means," "symbol control means," and "win means." The claim has been treated as such.

9. Claims 26-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 26: The claim recites the limitation "the symbols" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Furthermore, the limitation "the symbols" in line 3 renders the claim indefinite because it is not clear how the symbols function or relate to the gaming assembly or the win designation. It is also uncertain whether "the symbols" are shared by all the gaming apparatuses forming the gaming assembly or whether each gaming apparatus has a respective set of symbols. It appears that each gaming apparatus has a symbol or group of symbols that has an associated variable win designation which is dependent upon a proportion of money entered into each of the gaming apparatuses. The claim has been treated as such.

Re claim 27: The claim is dependent upon claim 26 and thus has the same deficiencies.

Additionally, the claim recites the limitations "the selection of the aforesaid symbol" in line 2, "the user" in lines 2-3, and "the amount of money accumulated" in line 3. There is insufficient antecedent basis for these limitations in the claim.

Furthermore, the limitation "the selection of the aforesaid symbol" in line 2 renders the claim indefinite because it is unclear how the selection step functions in the gaming assembly or a gaming apparatus. It appears that at least one of the symbols with a variable win designation must be selected to win a portion of the total money collected from all the gaming apparatuses. The claim has been treated as such.

Re claim 28: The claim is dependent upon claim 26 and thus has the same deficiencies.

Additionally, the claim recites the limitation "the gaming apparatus" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change "the gaming apparatus" to -- each of the plurality of gaming apparatuses --.

Furthermore, the limitations "variable win designation" and "win designation" render the claim indefinite. Claim 26 discloses a "variable win designation" that appears on at least one symbol in line 3 and claim 28 discloses a "win designation" that appears on every symbol in line 4. It is not clear whether there may exist symbols with both a "win designation" and a "variable win designation" or whether there are some symbols with a "variable win designation" and the rest of the symbols have a "win designation." It appears that the symbols have either a variable win designation or a win designation. The claim has been treated as such.

### *Claim Rejections - 35 USC § 102*

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 15-17 and 20-23, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Baerlocher et al. (US 2002/0151350 A1).

Re claim 15: The limitations "symbol providing means for..." in lines 1-2, "display means for..." in lines 3-4, "symbol control means for..." in lines 4-8, "selection means operable by the user for..." in lines 8-9, and "win means for..." in lines 11-13 invoke 35 U.S.C. 112, sixth paragraph. Baerlocher et al. discloses a gaming device comprising a processor 38 and a memory device 40, which includes random access memory (RAM) 42 and read only memory (ROM) 44 (see ¶ [0033]). The ROM stores program code that controls the gaming device and executes the game in compliance with its rules. The processor, RAM, and ROM are a symbol providing means for providing a plurality of symbols, each symbol having a respective win designation (see Figs. 3 and 4; ¶ [0038]), a symbol control means for providing each symbol with a viewable condition in which the respective win designation can be displayed on the display means, and a non viewable condition in which the respective win designation cannot be viewed (see ¶ [0040] - ¶ [0041]), and a win means for registering the final symbol to be selected and providing a win in accordance with the win designation of the final symbol (see ¶ [0038], lines 1-4; ¶ [0043], lines 7-9). The gaming device also comprises a display device 32 that functions as a display means

for displaying each symbol to a user (see Fig. 1; ¶ [0037], lines 8-10) and a touch screen 46 that functions as a selections means operable by the user for selecting each symbol in turn, wherein upon selection of each symbol, the respective symbol is disposed in its viewable condition (see Fig. 2; ¶ [0034], lines 7-11; ¶ [0042], lines 1-7).

Re claim 16: The teachings of Baerlocher et al. as applied to claim 15 have been discussed above. Baerlocher et al. further discloses the selection means/touch screen is operable to select each symbol on specific selection of the respective symbol by the user (see ¶ [0034], lines 7-11; ¶ [0040], lines 3-4).

Re claim 17: The teachings of Baerlocher et al. as applied to claim 15 have been discussed above. Baerlocher et al. further discloses the selection means is configured to select the aforesaid final symbol when the user has selected the penultimate symbol (see ¶ [0042], lines 4-7), ¶ [0043], lines 7-10).

Re claims 20-23: The teachings of Baerlocher et al. as applied to claim 15 have been discussed above. Baerlocher et al. further discloses the win designations represent values, monetary values/credits, multiples of an amount, or multiples of a monetary amount (see Figs. 3 and 4; ¶ [0041], lines 14-17).

12. Claims 26 and 27, as understood, are rejected under 35 U.S.C. 102(e) as being anticipated by McClintic (US 2003/0114220 A1).

Re claim 26: McClintic discloses a gaming device comprising a plurality of gaming apparatuses associated with each other $G_1$, $G_2$, ... , $G_N$ (see Fig. 2, ¶ [0038]), wherein at least one symbol has a variable win designation, the variable win designation being dependent upon a proportion of money entered into each of said gaming apparatuses for the purposes of playing (see ¶ [0013], ¶ [0049]).

Re claim 27: The teachings of McClintic as applied to claim 26 have been discussed above. McClintic further discloses the selection of the at least one of the symbols with a variable win designation results in the user winning a portion of the amount of money accumulated from each of the gaming apparatuses (see ¶ [0043]).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 18 and 19, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al.

The teachings of Baerlocher et al. as applied to claim 18 have been discussed above.

However, Baerlocher et al. fails to disclose or fairly suggest the symbols are representations of cards or playing cards.

The use of symbols as representations of cards or playing cards was well known in the art at the time the invention was made.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the symbols in the gaming device of Baerlocher et al. to represent cards or playing cards in order to provide a theme for the gaming device that relates to cards or playing cards.

15. Claims 24 and 25, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al. in view of Thomas et al. (European Patent Application EP 0945837 A2).

The teachings of Baerlocher et al. as applied to claim 15 have been discussed above.

However, Baerlocher et al. fails to disclose or fairly suggest the win designations are the same or vary each time the apparatus is used.

Thomas et al. teaches a bonus game for a gaming machine where the arrangement of bonus selections is reordered every time the bonus game is played. Thomas et al. also teaches that the arrangement of selection elements may also be varied according to the game program, which includes having the arrangement of selection elements the same each time game is played (see Page 7, lines 45-49).

Therefore, in view of Thomas et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to rearrange or maintain the arrangement of win

designations in the gaming device in order to change the difficulty of the game, i.e. make the game harder/more random by rearranging the win designations or make the game easier by maintaining the arrangement of win designations.

16. Claim 28, as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over McClintic in view of Baerlocher et al.

The teachings of McClintic as applied to claim 26 have been discussed above.

However, McClintic fails to disclose or fairly suggest the gaming apparatus disclosed in claim 28 and claim 1.

The teachings of Baerlocher et al. as applied to claim 1 have been discussed above.

Therefore, in view of Baerlocher et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gaming devices of Baerlocher et al. to function in the gaming machine network of McClintic in order to increase the appeal of the game with larger payouts.

***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Joshi (US 6,485,367 B1) discloses a self-learning gaming machine. Hughs-Baird (US 6,726,565) discloses a gaming device having an input-output value bonus scheme. Hughs-Baird (US 6,875,108) discloses a gaming device having a multiple selection large award bonus scheme.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin W. Lee whose telephone number is 571-270-1346. The examiner can normally be reached on Mon - Thurs (7:30AM-5PM), or Alt. Fri (7:30AM-4PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee can be reached on 571-272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bwl/
Benjamin W. Lee
November 15, 2006

KIM NGUYEN
PRIMARY EXAMINER